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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,242	08/13/2001	Stephen F. Gass	SDT 306	8807
27630	7590	02/28/2005	EXAMINER	
SD3, LLC 22409 S.W. NEWLAND ROAD WILSONVILLE, OR 97070			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,242

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,8,10 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,10 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 19-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/6/04; 8/17/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: 1449's 4/24/04; 4/17/04; 3/7/04; 2/12/04; 2/3/04; 11/1603; 8/16/03; 8/10/03; 3/15/03; 9/9/02.

## **DETAILED ACTION**

1. It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention. It should further be noted that rejections under 35 U.S.C 102(a) and 102(e) using the same U.S. Patent Applications/Publications have not been made because they do not qualify as prior art as there filing dates are not before the filing date of the instant application. Additionally, it should be noted that the below double patenting rejections are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, applicant's help in determining all appropriate double patenting rejections with all of applicant's applications is requested do to the large number of similar applications.

### ***Election/Restrictions***

2. Applicant's election of Group 1 (claims 2, 4-5, & 7-14) in the reply filed on 1/16/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. It should be noted that the restriction requirement is moot at this point because of applicant's amendment filed 10/7/04, wherein claims 1, 5, 8, and 10 were amended; claims 2-4, 6-7, and 11-18 were canceled; and claims 19-29 were added. Currently, claims 1, 5, 8, 10, and 19-29 are pending in the instant application.

### **SPECIAL CIRCUMSTANCES OF THIS APPLICATION**

Even if a copending application is listed on this instant application or other copending applications or patents and the material information is technically of record in one or more parent or copending applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Moreover, applications, which may not have any direct relationship, as continuing applications, to other copending applications by the same assignee may not be readily apparent due to the unusually large number of applicant's cases.

Applicant should point out such material information to the examiner of the instant application if the criterion for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner. This should include a listing of all related cases whether previously filed, recently filed, currently being filed, or patented.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

#### **37 CFR 1.56. Duty to disclose information material to patentability.**

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or
  - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

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### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 of copending Application No. 10/251,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 11-20 of copending application 10/251,576 anticipates the language of claim 1 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 5, 8, and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-12, and 14-19 of copending Application No. 09/955,418. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1, 9-12, and 14-19 of copending application 09/955,418 anticipates the language of claims 1, 5, 8 and 10 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 5, 8, and 25-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-29 and 35-40 of copending Application No. 09/676,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1, 9-12, and 14-19 of copending application 09/955,418 anticipates the language of claims 1, 5, and 9-10 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 8, 10, and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4,

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5, 7, and 20-35 of copending Application No. 10/051,782. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1, 4, 5, 7, and 20-35 of copending application 10/051,782 anticipates the language of claims 8, 10, and 29 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1, 5, 8, 10, 25-27, and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/643,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1-10 of copending application 10/643,296 anticipates the language of claims 1, 5, 8, 10, 25-27, and 29 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1, 5, 8, and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/794,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1-20 of



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copending application 10/794,161 anticipates the language of claims 1, 5, 8, 10, 25-27, and 29 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foreign Document DE 19609771, hereinafter DE '771, in view of Friemann et al., U.S. Patent 3,858,095.

DE '771 discloses the invention substantially as claimed including: a circular saw bench with hand recognition for retracting the blade upon detection the users hand near the saw; however, DE '771 lacks the specific detection system capable of detecting contact between the user and the blade. Friemann et al. discloses that it is old and well known in the art to sense contact between a user and a blade for the purpose of preventing injury to the user while allowing the user greater flexibility of movement of the hands around the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modified the device of DE '771 with a contact system capable of detecting contact between the user and blade for the

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purpose of preventing injury to user while allowing greater flexible work around the blade.

14. Claims 5, 8, and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over DE '771 in view of Friemann as applied to claim 1 above, and further in view of Terauchi, U.S. Patent 4,512,224.

The modified device of DE '771 discloses the invention substantially as claimed except for the brake mechanism configured to stop the rotation of the blade upon detection contact by the detection system; however, Terauchi discloses that it is old and well known in the art to stop the rotation of a blade while retracting the blade upon detection of an unsafe condition for the purpose of preventing damage to the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a brake mechanism with the modified device of DE '771 in order to further prevent any damage during an unsafe condition.

As to claims 8 and 10, it should be noted that current claim language is not limited to a brake system that causes the tool to move at least partially out the cutting region but rather occurs simultaneously, that is, upon activating the braking mechanism the retracting mechanism is also retracted which is the case with the modified device of DE '771.

15. Claims 25 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., U.S. Patent 5,791,224 in view of Foreign Document DE 19609771, hereinafter DE '771, and Friemann et al., U.S. Patent 3,858,095.

Suzuki discloses the invention substantially as claimed except for the reaction system for retracting the blade from the cutting zone upon detection of contact between the user and the blade. However, DE '771 discloses that it is old and well known in the art to use a circular saw bench with hand recognition for retracting the blade upon detection the users hand near the saw for the purpose of protecting the use. DE '771 lacks the specific detection system capable of detecting contact between the user and the blade. Friemann et al. discloses that it is old and well known in the art to sense contact between a user and a blade for the purpose of preventing injury to the user while allowing the user greater flexibility of movement of the hands around the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modified the device of Suzuki with a retraction system for retracting the blade upon detecting contact between the user and blade for the purpose of preventing injury to user while allowing greater flexible work around the blade.

As to claims 28-29, the modified device of Suzuki et al. discloses the retraction systems upon detection of the contact therefore, has a linkage and mounting system allowing for the retraction for blade. Claims 28 and 29 do not add any specifics to the linkage system or the mounting system defining over the prior art.

16. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of DE '771 and Friemann as applied to claim 25 above, and further in view of Terauchi, U.S. Patent 4,512,224.

The modified device of Suzuki et al. discloses the invention substantially as claimed except for the brake mechanism configured to stop the rotation of the blade

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upon detection contact by the detection system; however, Terauchi discloses that it is old and well known in the art to stop the rotation of a blade while retracting the blade upon detection of an unsafe condition for the purpose of preventing damage to the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a brake mechanism with the modified device of Suzuki et al. in order to further prevent any damage during an unsafe condition.

As to claims 8 and 10, it should be noted that current claim language is not limited to a brake system that causes the tool to move at least partially out the cutting region but rather occurs simultaneously, that is, upon activating the braking mechanism the retracting mechanism is also retracted which is the case with the modified device of DE '771.

### ***Allowable Subject Matter***

17. Claims 19-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The references cited are to show similar devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
February 20, 2005